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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,381	01/23/2006	Julen Burgou Arteche	R.306459	5559

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EXAMINER

GONZALEZ, MADELINE

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

10/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,381

Applicant(s)

ARTECHE ET AL.

Examiner

MADELINE GONZALEZ

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In response to applicant's amendment dated July 31, 2009

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 18, 20, 22-31 and 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Best et al. (U.S. 2,477,716) [hereinafter Best].

With respect to **claim 15**, Best discloses a filter, as shown in Fig. 1, having:

- a filter housing 5;
- at least one substantially elongated flat filter element 31, said filter element 31 contained in the housing 5, the at least one substantially flat filter element 31 being embodied overall as planar or flat in shape having a clean side and a

- dirty side which are both substantially planar and are situated essentially, parallel to each other;
- the clean side being disposed between a first elongated surface (such as top surface of filter element 31) of the flat filter element 31 and a first side of the housing 5; and
 - the dirty side being disposed between a second elongated surface (such as the bottom surface) of the flat filter element 31 and a second side of the housing 5, which second elongated surface opposes the first elongated surface;
 - an inlet 14 and an outlet 22a; and
 - at least one wall 7, 8, encapsulating the clean side or the dirty side of the filter element 31, the at least one wall 7, 8, being disposed between that side of the filter element 31 and the filter housing 5, wherein the filter element 31 and the at least one wall 7, 8, together constitute a filter insert which is inserted into the housing 5 (see col. 1, lines 8-19 and 51-52 and col. 2, lines 50-52).

In the alternative, to provide the filter element 31 of Best as planar or flat in shape would have been obvious to one of ordinary skill in the art at the time the invention was made since the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)). Furthermore, it is very common in the art

the provision of flat or planar filter elements, as well as filter elements having other configurations, such as circular, etc.

With respect to **claim 18**, Best discloses wherein the filter insert includes an encapsulated clean side that is connected to the outlet 22a, as shown in Fig. 2.

With respect to **claims 20 and 22**, Best discloses wherein the filter insert includes an encapsulated dirty side that is connected to the inlet 14, as shown in Fig. 2.

With respect to **claims 23 and 24**, Best discloses two or more filter elements 31 contained in the filter housing 5, as shown in Fig. 2.

With respect to **claim 25**, Best discloses wherein at least one of the inlet or the outlet is situated at an end of the filter housing 5, as shown in Fig. 2.

With respect to **claim 26**, Best discloses wherein the inlet and the outlet are situated at opposite ends of the filter housing 5, as shown in Fig. 5.

With respect to **claim 27**, Best discloses a flow entry 14 that at least reduces turbulence in the region of the side where the flow strikes the filter element, as shown in Fig. 2.

With respect to **claims 28 and 29**, Best discloses a flow baffle 13, 18, provided in the inlet 14, as shown in Fig. 2.

With respect to **claim 30**, Best discloses wherein the flow baffle 13, 18, is inclined upward in relation to the flow direction, as shown in Fig. 3.

With respect to **claim 31**, Best discloses wherein the filter housing 5 includes a block-shaped housing part and a cover 6 that closes the housing part, as shown in Fig. 1.

With respect to **claim 34**, Best discloses a distribution stabilizer 13, 18, on the inlet side, as shown in Fig. 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16, 17, 19, 21 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Best (U.S. 2,477,716) in view of Hopkins et al. (U.S. 5,620,599) [hereinafter Hopkins].

With respect to **claim 16**, Best **lacks** a folded filter material.

Hopkins discloses a filter assembly 100, as shown in Fig. 1, having a filter element 302 that can have any configuration. A pleated configuration is advantageous because it provides more filtration surface area within a given volume and reduces the hold-up volume of the filter element (see col. 4, lines 6-21). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the filter disclosed by Best with a folded filter as taught by Hopkins in order to provide a filter with more filtration surface area within a given volume and reduce the hold-up volume of the filter element (see col. 4, lines 6-21).

With respect to **claim 17**, Hopkins discloses wherein the filter material is folded essentially into the shape of a block, as shown in Fig. 2.

With respect to **claim 19** Best discloses wherein the filter insert includes an encapsulated clean side that is connected to the outlet 22a, as shown in Fig. 2.

With respect to **claim 21**, Best discloses wherein the filter insert includes an encapsulated dirty side that is connected to the inlet 14, as shown in Fig. 2.

With respect to **claim 32**, Best discloses wherein the filter housing 5 includes a block-shaped housing part and a cover that closes the housing part, as shown in Fig. 1.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Best (U.S. 2,477,716).

With respect to **claim 33**, Best **lacks** a nondetachable connection between the housing part and the cover.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the connection between the housing part and the cover disclosed by Best nondetachably, as claimed by applicant, in order to facilitate its handling, since the courts have held that the use of a one piece construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering choice. (*See MPEP 2144.04 [R-1] (V) [In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)]*).

Response to Arguments

Applicant's arguments with respect to claims 15-34 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that Best lacks the filter element and at least one wall constituting a filter insert which is inserted into the housing: Best teaches at least one wall 7, 8, encapsulating the clean side or the dirty side of the filter element 31, the at least one wall 7, 8, being disposed between that side of the filter element 31 and the filter housing 5, wherein the filter element 31 and the at least one wall 7, 8, together

constitute a filter insert which is inserted into the housing 5 (see col. 1, lines 8-19 and 51-52 and col. 2, lines 50-52).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M, T, Th, F- 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/
Primary Examiner, Art Unit 1797

Madeline Gonzalez
Patent Examiner
October 8, 2009